

## REMARKS

Most of the amendments above are formal only, for example, addressing multiple dependency and dependency. A nucleic acid that discriminates bioactive from non-bioactive ghrelin is taught, for example, on page 5, 3<sup>rd</sup> full paragraph, first sentence of the application. Accordingly, no issue of new matter arises, and entry of the amendments is requested respectfully.

I. In the plural Election of Species presented at pages 5-7 of the Office Communication mailed 24 June 2008, the Examiner requested three elections. Applicants hereby raise issues with two of the three elections.

a) In the first election, the Examiner parsed an L nucleic acid, a DNA, an RNA and a combination of DNA and RNA.

Applicants point out that an L nucleic acid can be a DNA or an RNA.

Hence, the election of L nucleic acid is generic to a DNA, an RNA or a combination of DNA and RNA. Accordingly, it is believed claim 8 also reads on the election of an L nucleic acid.

b) In the second election, the Examiner parsed, among other alleged species, a nucleic acid with a secondary structure as provided in Figure 1B (claim 9), a nucleic acid with that secondary structure and with a variable internal loop (claim 10) as well as the nucleic acids of SEQ ID NOs:1-15 (claims 11 and 12).

Applicants point out that all of the nucleic acids of claims 10-12 have the secondary structure of Figure 1B. Moreover, SEQ ID NO:1 is generic and includes the nucleic acids of SEQ ID NOs:2-15.

Hence, the election of a nucleic acid with a secondary structure as shown in Figure 1B is generic to all of the nucleic acids of claims 10-12. Thus, it is believed claims 10-12 also read on the elected species of a nucleic acid with a secondary structure as provided in Figure 1B.

Accordingly, in view of the election of L nucleic acid and of a secondary structure of Figure 1B, it is believed claims 8 and 10-12 also read on the elected species. In addition, new dependent claims 79-81 read on the elected species.

II. On the Office Action Summary page, priority under 35 U.S.C. 119 was not acknowledged.

The instant application is a 371 filing of PCT Ser. No. EP04/12739 filed 10 November 2004, which claims benefit to EP Ser. No. 03025743.0 filed 10 November 2003, as provided on the Application Data Sheet, the executed Declarations and the Official Filing Receipt, all of record. Moreover, a certified copy of the priority document should have been made available by WIPO.

Hence, acknowledgement of the claim for priority is requested respectfully.

III. A second Information Disclosure Statement was filed 30 January 2009. Applicants respectfully request the initialed copy of the Form 1449 in the next communication from the Office.

IV. At the top of page 2 of the Office Action, the Examiner raised an issue with respect to the Sequence Listing. No detailed description of the alleged deficiencies was attached to the Office Action or was located on PAIR. What was located on PAIR was the New Sequence Listing Error Summary dated 19 May 2006. That form was used to address the issues of using n or Xaa and amending the <213> entries.

Attached hereto is a paper copy and computer readable form of the revised Sequence Listing that addresses those formal aspects of the listing. The content of the attached paper copy and computer readable form of the revised Sequence Listing is the same.

Also, the legend of Fig. 1B now carries a sequence identifier.

Hence, withdrawal of the objection is requested respectfully.

V. Beginning on page 4 of the Office Action, the Examiner rejected claims 1, 2, 4-7 and 9 for an alleged want of written description under 35 U.S.C. 112, first paragraph.

The rejection is traversed for the following reasons.

Solely for the purpose of compact prosecution, claim 1 has been framed in the context of SEQ ID NO:1 which specifically binds a bioactive n-octanoyl ghrelin target.

On page 6, the Examiner raised the issue that SEQ ID NO:1 does not seem to indicate a common structure of the nucleic acids that bind biologically active ghrelin.

SEQ ID NO:1 is a core or degenerate sequence which encompasses, for example, the nucleic acids of SEQ ID NOs:2-15, all of which have the elected structure and which specifically bind only to bioactive n-octanoyl ghrelin and do not bind to non-bioactive des-octanoyl ghrelin.

As artisan would well recognized on reading the instant specification that the inventors were in full possession of the claimed invention.

In view thereof, withdrawal of the rejection is in order.

VI. At the bottom of page 7 of the Office Action, claims 1, 2, 4-7 and 9 were rejected under 35 U.S.C. 102(e) over WO2004/13274.

The rejection is traversed for the following reasons.

The published PCT application does not necessarily teach a nucleic acid which specifically binds only to bioactive n-octanoyl ghrelin and not to des-octanoyl ghrelin. For example, in the screening assays of Examples 3, 5 and 7, D-ghrelin as compared to bioactive ghrelin or an n-octanoyl ghrelin was used for the binding studies. Moreover, the published PCT does not necessarily teach the instantly claimed SEQ ID NO:1.

Thus, anticipation does not lie, and the rejection can be removed.

VII. On pages 10 and 11 of the Office Action, claim 1 was rejected under the judicially-created doctrine of obviousness-type double patenting over claim 1 of a copending application. The Examiner noted that one case relates to ghrelin and the other to bioactive ghrelin.

The rejection is traversed for the following reasons.

The teachings of the cited copending application do not relate to nucleic acids that specifically bind only to bioactive n-octanoyl ghrelin and do not bind to non-bioactive des-octanoyl ghrelin. Moreover, that copending application does not necessarily teach or suggest SEQ ID NO:1 claimed herein. Without such teaching, there is no basis to conclude there is a reasonable suggestion of obtaining the instant invention from the teachings of that copending application with a reasonable expectation of success or with reasonable predictability (Eaton et al., Bioorg Med Chem, 5(6):1087-1096, 1997). Hence, a prima facie case of obviousness has not been made, and the rejection can be removed.

## CONCLUSION

Applicants have taken steps to place the instant application in condition for allowance. Reexamination, reconsideration, withdrawal of the objection and rejections, and early indication of allowance are solicited earnestly. If any issues remain unresolved, the Examiner is invited to contact the undersigned at the local exchange noted below.

Respectfully submitted,

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